

REMARKS

The Official Action of 8 July 2005 has been carefully considered and reconsideration of the application as amended is respectfully requested.

The courtesy of Examiners Nolan and Kim in conducting a telephone interview with the undersigned on 18 October 2005 has been noted with appreciation. The Interview Summary mailed 18 October 2005 accurately reflects what transpired at the interview, as amplified next.

In the interview, the Examiners agreed that they would not have a problem with subparts (b) or (c) of proposed claim 35 in the Proposal for Interview (copy submitted herewith) as far as written descriptive support is concerned. In other words, they agreed that these subparts of the claim would not prompt a rejection under the written description provisions of 35 USC 112, first paragraph. They did, however, indicate that they would have to do an expanded search to ascertain whether there are, for example, full length proteins in the prior art **comprising** the sequences recited in subpart (b) of the claim. In view of the open ended nature of the "comprising" transitional, it was their opinion that these sequences encompass full length proteins so long as they comprise the recited sequences and that an updated search is needed to determine whether there are any such proteins.

With respect to subpart (a), the examiners initially queried whether the specification conveys that, at the time the application was filed, the inventors considered that a fragment of

SEQ ID NO:3 "consisting of at least 6 contiguous amino acids of SEQ ID NO:3" was part of their invention. The examiners pointed out that the alignment from Table 5 provided in the Remarks of our Proposal for Interview does not appear in Table 5 of the application as filed, and queried whether there is no basis for a recitation of 6 contiguous amino acids as opposed, for example, to 5 or 7. Applicants argued that (a) it would be clear from Table 5 in the specification as filed that the inventors were examining peptides **derived from** P54 (SEQ ID NO:3); (b) "peptides derived from" P54 implies that the inventors envisaged at least a certain similarity in structure between P54 and its derivatives; and (c) all of the described derivatives have at least 6 contiguous amino acids in common with P54 and this is the least common denominator. Applicants argued that, on this basis, it is clear that the inventors considered that, for a modified peptide to be considered to be a derivative of P54 that might provide similar inhibitory activity, it should have at least 6 contiguous amino acids of P54.

The examiners admitted that this is a gray area wherein each case must be determined on its facts, and agreed to consider Applicants argumentation. They asked that Applicants submit argumentation in writing. They also indicated that, even if they agree with Applicants, there is a question as to whether the prior art shows a longer protein comprising one of the recited fragments of SEQ ID NO:3. They would do a search to determine this.

In view of the new issues raised by the proposed claim, and in view of the necessity to expand the search, the examiners advised that Applicants would have to file a continuation application or Request for Continued Examination (RCE) for prosecution of the proposed

claim. This being the case, Applicants have now decided to cancel from the present application the subject matter which the Examiners indicated would require further consideration and to gain an allowance of the subject matter which has been indicated to be free of the prior art. (The cancellation is without prejudice to Applicants' right to file a continuing application drawn to the canceled subject matter.)

In this latter connection, the indication that claims drawn to peptides "consisting of" SEQ ID NOs: 1-10 are free of the prior art has been noted with appreciation. Claim 16 has now been canceled, and claims 17-24 and 32-34 have now been amended so that they are restricted to the peptides consisting of SEQ ID NOs: 1-10. Since these claims are considered to be free of the prior art, and since the rejections under 35 USC 112, first paragraph have **not** been applied against the subject matter now claimed, it is respectfully believed that these claims are now in condition for allowance.

With respect to claims 26-31, Applicants respectfully request rejoinder of these claims pursuant to the provisions of MPEP Section 821.04 since they are method of use claims which depend from allowable product claims and contain all of the limitations of the allowable product claims.

In view of the above, it is respectfully submitted that all rejections and objections of record have been overcome and that the application is now in allowable form. An early notice of allowance is earnestly solicited and is believed to be fully warranted.

Respectfully submitted,

CLIFFORD J. MASS  
LADAS & PARRY LLP  
26 WEST 61ST STREET  
NEW YORK, NEW YORK 10023  
REG. NO.30,086(212)708-1890